



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/900,360 | 07/25/1997 | WELLS OBRECHT | 2569-0103P | 8032 |

2292 7590 08/23/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

| EXAMINER |
|----------|
|----------|

MEINECKE DIAZ, SUSANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3623

DATE MAILED: 08/23/2002

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Appellant's Request for Clarification filed on April 19, 2002

1. The declaration filed on July 3, 2001 under 37 CFR §1.131 has been considered but is ineffective to overcome the *Source Interactive Software* references applied in the art rejection. MPEP §715.07 states:

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Appellant has presented no specific evidence to support conception and due diligence regarding development of the claimed invention. Further, Appellant has quoted the Examiner out of context. On page 1 of Appellant's Declaration Under 37 C.F.R. §1.131, Appellant states, "In an Examiner's Answer, the Examiner stated in reply to that question, the following: 'however, the inventor only need to swear back to at least **December 14, 1995**' (Emphasis Added)." In actuality, the Examiner had made the following statement on pages 22-23 of the Examiner's Answer (Paper No. 20): "Consequently, the inventor needs to swear behind the *Source Interactive Software* as a whole, **taking into account its earliest date of disclosure (August 22, 1995)**, in order to provide the most effective declaration under 37 CFR 1.131. However, the inventor

only need swear back to at least December 14, 1995 **to overcome the disclosure of the Internet embodiment** of *Source Interactive Software*." (*Emphasis added*) Since Appellant provides no evidence to support conception and due diligence regarding the claimed invention, it is not clear whether the Appellant is even asserting that he conceived of the *Internet implementation* of his invention prior to December 14, 1995. Even if Appellant were to provide evidence to this effect, Appellant must still swear behind the non-Internet version of *Source Interactive Software*, which dates back as far as August 22, 1995 (as disclosure in Reference "U", "Interactive Buyers Net: Buyer/Seller Interactive Software Inc. Acquired, New Software Introduced"). Therefore, Appellant's declaration under 37 CFR §1.131 is ineffective to overcome the *Source Interactive Software* references applied in the art rejection.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

Application/Control Number: 08/900,360

Page 4

Art Unit: 3623

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

SMD 

August 22, 2002


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600